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REMARKS

This paper is responsive to an Office Action mailed on June 29, 2006. Prior to this response, claims 1-2, 4-14, and 16-27 were pending. Claims 1-2, 4-14, and 16-27 remain pending.

In Section 3, the Office Action states that claims 1-2, 4-9, 11-14, 16-23, and 25-27 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Seder et al. ("Seder"; US 6,694,043). With respect to claims 1, 13, 14, and 26-27 the Office Action states that Seder describes a profile, a profile address field, a profile encryption field, the storing of profiles in a directory, the selection and association of a profile with a scanned document, and the transmission of the scanned document responsive to the profile address and encryption fields. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Generally, Seder describes a stenographic encoding system which creates a watermark that is (invisibly) superimposed on a document. Upon photographing the document, the watermark can be detected. Once identified, the watermark may be used to prompt an action, such as identifying the file name of the document (col. 1, ln. 30-54).

In contrast, the invention of claims 1, 13-14, and 26-27 describes a directory of profiles. Each profile includes an address field and an encryption field. After scanning a document, a user selects a profile. The selection of a profile from the directory automatically sends the scanned document to a particular address, using a particular form of encoding, as specified in the fields of the selected profile.

Seder appears to describe none of the elements recited in the Applicant's independent claims. Claim 1 for example, recites a profile with an address field and an encryption field. The Office Action states that Seder describes a profile at col. 2, ln. 63-67. However, the cited portion of Seder discloses the "payload" associated with a watermark. Information may be literally encoded in the payload (col. 2, ln. 57-58), or the payload can be used as an index to another repository where additional information (metadata) associated with the document may be stored as a "record". A watermark cannot be a profile, because the Applicant has specifically recites that a profile is a text file. Neither is Seder's record the same as the Applicant's profile. Seder's record identifies a particular document in storage. The Applicant's profile is not used to identify a document, or to access a stored document.

The Office Action states that a profile address field is disclosed at col. 3, ln. 52-53. The cited section of Seder discloses an embodiment where a stored document is presented on a user screen as a

response to identifying a watermark (col. 3, ln. 39-44). Seder notes that the addresses of stored documents may change, and describes a software program (daemon) that monitors the movements of documents in a database. The Applicant respectfully submits that this document-tracking daemon is not associated with the watermark or the watermark payload. Therefore, the software daemon cannot be considered a "profile address field". Further, the Applicant notes that a profile address field, as recited in the Applicant's claims and described in the specification, is a destination to which a document is sent, not an address from which a stored document is retrieved.

The Office Action states that Seder discloses a profile encryption field at col. 6, ln. 18-24. Seder states that printed documents may be encrypted, and the encryption key created as a watermark on the document. In the cited section of text, however, Seder merely states that printed documents may point to encryption keys that permit electronic access to unrelated documents.

The Office Action states that Seder describes the sending of an encrypted document to a destination in response to a profile address field. At col. 4, ln. 28-33, Seder describes a hypertext link embedded in a document. A hypertext link is not a profile address field. That is, the document is not sent to the hypertext link address. Seder describes an option of encoding a key in a watermark, to retrieve an encrypted electronic document (col. 6, ln. 8-12). Again, a watermark is not a profile, and creating a watermark decryption key is not the same process as using a profile to encrypt a scanned document prior to transmission.

To summarize, Seder discloses a watermark associated with a printer document, which may point to a record of document information

record, while the Applicant recites a profile which may be selectively associated with a scanned document. Seder's system can be used to locate a stored document, while the Applicant's profile address field is used to send a scanned document to an address. Seder's system can be used to decrypt a printed document or to gain access to unrelated documents, while the Applicant's encryption field is used to encrypt a scanned document prior to transmission.

The Applicant respectfully requests that the recited claim elements of a "profile", "profile address field", and "profile encryption field" be interpreted as they are defined in the claims. In the event of ambiguity, these claim terms should be interpreted as they are defined in the specification.

The current consensus of the CAFC is that the claims are to be interpreted in light of the supporting specification, as described in *Phillips v. AWH Corp.* No. 03-1269 (Fed. Cir. 7/12/2005). In this decision, the Court stated:

"Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. This court explained that point well in *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998):

It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed. Such person is deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field. The inventor's words that are used to describe the invention-the inventor's lexicography-must be

understood and interpreted by the court as they would be understood and interpreted by a person in that field of technology. Thus the court starts the decisionmaking process by reviewing the same resources as would that person, viz., the patent specification and the prosecution history."

The profile, with address and encryption fields, is discussed in the Applicant's specification at page 7, lines 11, through page 3, line 20, and shown in Fig. 2. Seder's use of watermarks and records does not disclose the use of a profile, profile address field, or profile encryption field, as defined in the Applicant's claims.

With respect to the *first prima facie* requirement, the Office Action fails to provide any motivation to suggest that a person skilled in the art would have found it obvious to modify Seder's system in such a manner as to yield the claimed invention. In fact, the Office Action merely states that, "it would have been obvious for a person of ordinary skill in the art that the electronic document as taught by Seder has been the scanned document because the equipment processing in Seder is operable to receive scanned documents."

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

The CAFC has consistently found over the years that a *prima facie* case for obvious must be based upon a detailed analysis of how and

why an expert could excerpt known art to make modifications to a cited prior art reference. A *prima facie* case cannot be supported by the simple statement that the Applicant's invention is made obvious merely because Seder's processing equipment may receive scanned documents.

In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art reference for combination in the manner claimed." *In re Rouffet*, 47 USPQ2d 1453, 1457-1458 (1998).

In the present case, the Applicant submits that it is impossible to support a *prima facie* case of obviousness. Returning to the first *prima facie* requirement, Seder's system is used for a totally different purpose than the Applicant's invention. Seder uses watermarks, identified on a printed document, or indexed records to identify a stored electronic document. The Office Action has failed to suggest, in even the most general way, how the identification of watermarks or indexed records points to a system which uses a profile to streamline the transmission of a scanned document. With respect to the second *prima facie* requirement, the Office Action provides absolutely no evidence of an expectation of success.

With respect to the third *prima facie* requirement, Seder does not explicitly suggest every limitation of the claimed invention. As noted above, Seder does not disclose a profile, a profile address field, a profile encryption field, the selection of a profile, the transmission of a scanned document in response to a selected profile, the transmission to the destination associated with the profile address field, or the encryption of the transmission in response to the profile encryption field. Since Seder

does not explicitly describe or suggest these claim elements, he cannot be said to make obvious all the limitations of independent claims 1, 13-14, and 26-27. Claims 2, 4-9, and 11-12, dependent from claim 1, and claims 16-23 and 25, dependent from claim 14, enjoy the same distinctions from the cited prior art reference, and the Applicant respectfully requests that the rejection be withdrawn.

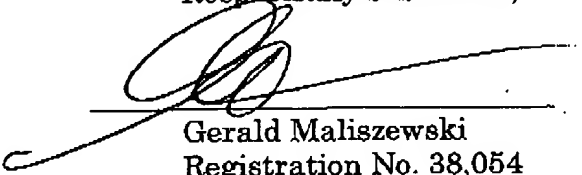
In Section 4 of the Office Action claims 10 and 23 have been rejected under 35 U.S.C. 103(a) as being unpatentable with respect to Seder in view of Hind et al., ("Hind"; US 6,980,660). The Office Action acknowledges that Seder fails to disclose certification authority, but states that it would have been obvious to include the public key encryption of Seder with the certificate authority taught by Hind. This rejection is traversed as follows.

Hind describes a method for encrypting wireless communications. Hind does not disclose the use of profiles, profile address fields, profile encryption fields, or the sending of scanned documents in response to selecting a profile from a directory. As noted above, the Office Action has not made a *prima facie* case to support the rejection of claims 1 and 14 as obvious with respect to Seder. Therefore, even if Hind can be combined with Seder, that combination still does not suggest or make explicit all the limitations of independent claims 1 and 14. Claims 10 and 23 enjoy the same distinctions over the prior art references, and the Applicant requests that the rejection be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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